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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,588	11/28/2003	Laurence B. Boucher	ALA-025	9422
24501	7590	12/23/2004		
MARK A LAUER 6601 KOLL CENTER PARKWAY SUITE 245 PLEASANTON, CA 94566			EXAMINER LIN, WEN TAI	
			ART UNIT 2154	PAPER NUMBER

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/724,588

Applicant(s)

BOUCHER ET AL.

Examiner

Wen-Tai Lin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/28/2003 and 6/24/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30-42 is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/28/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/24/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-8 and 10-42 are presented for examination, wherein claim 9 does not exist in the filed application.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 15 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6247060.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the sole difference in both cases characterized by the the terms "protocol processing stack" (as cited in the U.S. Patent No. 6247060) and "a central

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processing unit running protocol processing instructions" (as cited in the instant application) are in fact functionally identical.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 15 recites the limitation "said CCB". There is insufficient antecedent basis for this limitation in the claim. Further, the term "CCB" is not defined in the claim language.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-8 and 10-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Szczepanek;[U.S. Pat. No. 5321819].

6. As to claims 1 and 16, Szczepanek; teaches the invention as claimed including: a system for communication between a local host [10, Fig.1]and a remote host that are connectable by a network [14, Fig.1], the system comprising:

a communication processing device (CPD) [224, Fig.6] that is integrated into the local host [226, 228, Fig.6] to connect the network and the local host, said CPD including hardware logic configured to process network packets [col.7, lines 29-59], , wherein said CPD and said CPU are configured such that a message transferred between the network and the local host is generally processed by said CPD instead of said CPU when said CPD controls said connection [note that since Szczepanek;'s CPD (i.e., the network adapter) is placed in between the local host and the network, a message transferred between the network and the local host must be processed at the CPD (see, e.g., col.7, lines 29-31) and the network connection is always under the control of the CPD].

Szczepanek; does not specifically teach that a central processing unit (CPU) in the local host runs protocol processing instructions in the local host to create a transport layer connection between the local host and the remote host.

However, it is well known in the art that when a networked client (i.e., via Szczepanek;'s local host) is connected to the Internet and makes a request to a remote

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host, a TCP session is normally created for communicating between the local host and the remote host.

It would have been obvious to one of ordinary skill in the art at the time the invention was made that the TCP transport layer connection, which is needed for HTTP communication over the Internet, would be initiated and/or processed at the local host, because Szczepanek;'s local host is able to connect to the Internet through its Ethernet interface.

7. As to claims 2-3, Szczepanek; further teaches that said hardware logic is configured to process Transmission Control Protocol (TCP) [col.44, lines 16-23; i.e., Szczepanek;'s adapter is able to process protocol layers other than a physical layer].

8. As to claim 4, Szczepanek; further teaches that said CPD is connected to said CPU by a bus [226-228, Fig.6].

9. As to claim 5, Szczepanek; further teaches that said CPD includes a communication processor [see 230 of Fig.6]. However, it is obvious that the a communication processor can be replaced by a microprocessor because the latter is functionally capable and is widely available.

10. As to claim 6, Szczepanek; further teaches that said CPD is connected to an input/output (I/O) controller [col.8, lines 7-16].

11. As to claim 7, Szczepanek; does not specifically teach that said I/O controller is a peripheral component interconnect (PCI) bridge.

However, Official Notice is taken that having a host bus interfaced to a PCI bridge is well known in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made that Szczepanek;'s CPD may be also connected to a PCI bridge through the commonly interfaced host bus because a PCI bridge makes Szczepanek;'s system expandable to conventional PCI cards.

12. As to claim 8, Szczepanek; further teaches that the system further comprises a memory that is disposed in said host and accessible by said CPU and said CPD [col.8, lines 37-40].

13. As to claim 10, Szczepanek; does not specifically teach that said CPD is integrated with a peripheral component interconnect (PCI) bridge. However, Official Notice is taken that having a network adapter integrated with a PCI bridge is well known in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to integrate Szczepanek;'s CPD with a PCI bridge because such a hardware arrangement would facilitate the access of data/information residing in the associated PCI cards.

14. As to claims 11-13, Szczepanek; further teaches that said CPD is integrated with a memory controller for said CPU, wherein said CPD is integrated with (and therefore is connected with) an I/O controller and a memory controller for said CPU [col.8, lines 1-62].

15. As to claim 14, Szczepanek; does not specifically teach that said CPD is connected to a hub interface bus that connects a memory controller to an I/O controller. It is well known in the art that a plurality of local network nodes may form as a local area network (LAN) by connecting them with a hub. Since Szczepanek;'s CPD is connected to an Ethernet, a form of local area network, it is obvious to one of ordinary skill in the art that Szczepanek;'s CPD may be connected to a hub interface when Szczepanek;'s Ethernet incorporates at least one hub to form an extended LAN.

16. As to claim 15, Szczepanek; further teaches that an ownership bit that designates whether said CPU or said CPD controls the memory [col.8, lines 29-36].

17. As to claims 17-29, since the features of these claims can also be found in claims 1, 4-6, 8 and 10-15, they are rejected for the same reasons set forth in the rejection of claims 1, 4-6, 8 and 10-15 above.

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18. Claims 30-42 are allowable because the prior art of record does not teach or suggest individually or in combination the features of determining whether a communication processing device should bypass the protocol handling on a packet-by-packet basis based on a control indication obtained from its associated local host.

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Teich; et al. [U.S. Pat. No. 6490631];

Radogna; et al. [U.S. Pat. No. 5991299];

Wang; et al. [U.S. Pat. No. 5913028];

Osborne; [U.S. Pat. No. 5790804];

Ram; et al. [U.S. Pat. No. 5941969];

Petty [U.S. PGPub 20030014544]; and

Isfeld; et al. [U.S. Pat. No. 5802278].

20. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 days from the mail date of this letter. Failure to respond within the period for response will result in ABANDONMENT of the application (see 35 U.S.C. 133, M.P.E.P. 710.02, 710.02(b)).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday (8:00-5:00) .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703)872-9306 for official communications; and

(571)273-3969 for status inquires draft communication.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

December 7, 2004

Wen-Tai Lin
12/7/04